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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,411	09/24/2003	Richard Dwyer Hiserodt	IFF-66	8392

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EXAMINER

COE, SUSAN D

ART UNIT PAPER NUMBER

1654

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,411

Applicant(s)

HISERODT ET AL.

Examiner

Susan D. Coe

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/15/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

1. Claims 1-8 are currently pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,880,630.

Applicant's claims are drawn to a composition comprising a plant extract that contains monomenthyl succinate. The plant sources of the extract are specifically claimed as *Lycium barbarum* or *Mentha piperita*. Synonyms for *L. barbarum* include *Lycium halimifolium* (see <http://davesgarden.com/pdb/go/63945>; www.orient-hospital.com/Eng/gouji.htm; and www.biosurvey.ou.edu/shrub/lyba4.htm). The common name for *L. barbarum* is wolfberry (see www.orient-hospital.com/Eng/gouji.htm). The method for making the extract comprises extracting the plant biomass with ethanol and filtering the extract to remove the biomass. The filtered solution contains the monomenthyl succinate.

US '630 teaches a method of making an extract from the plant *Lycium halimifolium*. The plant is extracted with ethanol and then filtered to obtain the extract solution (see column 2, lines 15-24).

The reference does not specifically teach that the plant extract contains monomenthyl succinate. However, the reference teaches making an extract from the same plant using the same solvent and same extraction steps as claimed. Thus, the reference extract would inherently have to contain all of the same components as the claimed extract including monomenthyl succinate. If the reference extract does not contain monomenthyl succinate then applicant's invention would not function as claimed.

3. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Derwent English abstract of CN 1174707 A.

CN '707 teaches an extract from Chinese wolfberry. The extract is made using a method comprising extraction with ethanol and then filtration to obtain the extract solution.

The reference does not specifically teach that the plant extract contains monomenthyl succinate. However, the reference teaches making an extract from the same plant using the same solvent and same extraction steps as claimed. Thus, the reference extract would inherently have to contain all of the same components as the claimed extract including monomenthyl succinate. If the reference extract does not contain monomenthyl succinate then applicant's invention would not function as claimed.

4. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 5,882,644.

US '644 teaches an extract from *Mentha piperita*. The extract is made using a method comprising extraction with ethanol and then filtration to obtain the extract solution (see column 5, lines 25-28 and lines 37-38).

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The reference does not specifically teach that the plant extract contains monomenthyl succinate. However, the reference teaches making an extract from the same plant using the same solvent and same extraction steps as claimed. Thus, the reference extract would inherently have to contain all of the same components as the claimed extract including monomenthyl succinate. If the reference extract does not contain monomenthyl succinate then applicant's invention would not function as claimed.

5. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.



Susan D. Coe
Primary Examiner
Art Unit 1654

November 24, 2004